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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT

Applicant: **Richard A. Brandt**

Serial No.: **09/528,560**

Filed: **March 20, 2000**

For: **VIBRATION DAMPING STRIKING
IMPLEMENT**

Attorney Docket: **06764.0004**

Examiner: **Mark S. Graham**

Art Unit: **3711**

Confirmation No.: **5896**

**CERTIFICATE OF
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May 15, 2003

Maxim H. Waldbaum

Response to November 8, 2001 Office Action

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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

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Sir:

In conjunction with the Petition to Revive the above-identified patent application of even date, the Applicant responds to the Office Action of November 8, 2001.

In the Office Action, the Examiner rejected claims 1, 2 and 9-11 as being unpatentable under 35 U.S.C. § 103(a) over Filice in view of Muhlhausen. Additionally, the Examiner also rejected claims 3-8 as being unpatentable under 35 U.S.C. § 103(a) over Filice in view of Muhlhausen in further view of Peng. The Applicant respectfully traverses the pending rejection and submits that the Examiner has not set forth a *prima facie* showing of obviousness to support either of the pending rejections. Consequently, both rejections must be withdrawn.

The Filice in view of Muhlhausen Rejection

The Examiner acknowledges that the claimed subject matter is contrary to that of the Filice patent. Specifically, the Examiner states that the disclosure of the Filice patent is “the reversal of the male/female connector elements”. Office Action at 2.

While the Applicant agrees that Filice teaches away from the claimed subject matter, the Applicant respectfully submits that the Examiner’s analysis is an oversimplification. It appears that this oversimplification has lead to an incorrect legal conclusion.

Specifically, both the claims (*e.g.*, claim 1) and Filice are directed to devices having a barrel handle component and a hollow handle component. *Inter alia*, the interface of these two components differs between that disclosed in Filice and that of the claimed subject matter.

The Examiner next alleges that Muhlhausen discloses the reversal of these elements. *Id.* The Applicant respectfully submits that Muhlhausen does not discloses the reversal of the elements of Filice. Rather, Filice describes a conventional bat barrel. *E.g.*, Fig. 2. In marked contrast to Filice, Muhlhausen does not describe a conventional bat barrel. Instead, Muhlhausen describes a:

detachable elongated contact surface member has a **width significantly less than the width of a regular bat** to enhance the eye-to-hand coordination to contact a pitched ball with such detachable elongated contact surface member having such reduced width. Col. 2, lines 42 - 47 (Emphasis added).

As a result, Muhlhausen is inconsistent with Filice. For example, if these references could be properly combined, is the barrel of the resulting bat detachable? Additionally, is the barrel of the resulting bat of “a width significantly less than the width of a regular bat”? The Office Action does not address either of these questions. Thus, for this reason alone, the Examiner has not shown that there is a sufficient teaching or suggestion to modify the

cited art to arrive at the claimed subject matter. Consequently, the Examiner has not made a *prima facie* showing that the claimed subject matter is obvious based upon a combination of the Filice and Muhlhausen patents. For this reason alone, the present rejection must be withdrawn.

Thus, Filice and Muhlhausen disclose different elements and consequently, neither is the reverse of the other.

The Applicant also respectfully submits that the standard for determining whether the claimed subject matter is obvious is that of *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966) and not *In re Gazda*, 219 F.2d 449, 104 U.S.P.Q. (BNA) 400 (C.C.P.A. 1955). In particular, the Applicant directs the Examiner's attention to Section 706.02(j) of the Manual of Patent Examining Procedure (entitled "Contents of a 35 U.S.C. 103 Rejection"). There it is explicitly stated that:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

As the present rejection does not fulfill any of the three basic criteria, the present rejection is improper and must be withdrawn.

**The Filice in view of Muhlhausen
in further view of Peng Rejection**

The Examiner has also rejected claims 3-8 based upon the combination of Filice and Muhlhausen in further view of the Peng. The Examiner alleges that the Peng patent discloses a locking member such as that claims.

The Applicant respectfully submits that addition of the Peng patent to the rational for the present rejection does not cure the defects associated with the rejection based upon Filice

In re Application of **Richard A. Brandt**

Serial No.: 09/528,560

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and Muhlhausen. Thus, this rejection is improper, and must be withdrawn, for the above stated reasons.

Additionally, the Peng patent is inconsistent with each of Filice and Muhlhausen. Thus the cited art does not teach or suggest any combination, much less the claimed subject matter. Specifically, as the Examiner acknowledges, Filice teaches a bat handle inside a bat barrel. Muhlhausen teaches a narrow rod partial inside a handle. In contrast to both Filice and Muhlhausen, Peng teaches a barrel separated from a handle, with neither inside the other. *See e.g., Fig. 3.* In sum, the cited references cannot be combined to form a rejection of the claimed subject matter. Thus, the resent rejection must be withdrawn.

The Applicant respectfully submits that the claims are in condition for allowance and respectfully solicits the same at an early date.

May 15, 2003

Respectfully submitted



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